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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
09/804,498	03/12/2001	John Christopher Barron	BSC-162	1361
28120	7590	10/04/2004	EXAMINER	
ROPES & GRAY LLP			DAVIS, DANIEL J	
ONE INTERNATIONAL PLACE			ART UNIT	PAPER NUMBER
BOSTON, MA 02110-2624			3731	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/804,498

Applicant(s)

BARRON ET AL.

Examiner

D. Jacob Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) 11-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6-10 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 5 is objected to. Applicants amended claim 1 to include the brittle embodiment, yet none of the materials of claim 5 were deleted. In response to this Office action, applicants must delete those materials that are not brittle.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4 are rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,961,329 to Stucki-McCormick. In Fig. 1, Stucki-McCormick discloses a dental implant that is considered a push-in bone anchor. The external surfaces comprise a hydroxyapatite coating (col. 7, lines 13-18). Hydroxyapatite coatings are inherently brittle and break. U.S. Patent No. 5,904,689 to Jonjic teaches in col. 4, lines 29-50, a titanium dental implant coated with hydroxapatite. As the patent explains, the hydroxyapatite, is a brittle coating that breaks off from the surface of the implant. Hydroxyapatite is inherently bioabsorbable.

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Claims 1 and 4 are rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,961,538 to Pedlick et al. Pedlick discloses in col. 10, lines 56-67 that the bone anchor is encapsulated within a brittle material, i.e., hydroxyapatite-containing-glass.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pedlick in view of U.S. Patent No. 5,545,178 to Kensey et al. Pedlick fails to disclose an antibiotic. Nevertheless, Kensey discloses an implant comprising an antibiotic that is located both on the surface of the implant or within the implant material (col. 17, lines 39-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an antibiotic in the either on the surface or disposed with the cover to prevent infection as taught by Kensey.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pedlick in view of WO 99/37216 to Gellman et al. Pedlick fails to disclose the use of an antibiotic or the specific material of the antibiotic. Nevertheless, Gellman teaches the use of an

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antibiotic having the recited materials of claim 8 (page 3, lines 23-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add an antibiotic of the recited materials as taught by Gellman in order to prevent infection.

***Allowable Subject Matter***

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicants' arguments filed August 30, 2004 have been considered but are moot in view of the new grounds of rejection.

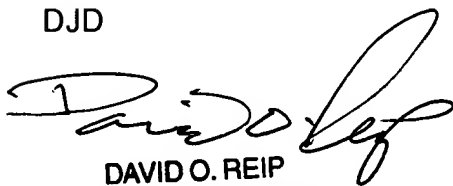
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (703) 305-1232. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (703) 308-2154. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD



DAVID O. REIP  
PRIMARY EXAMINER